

USSN: 09/757,175
Atty. Docket No.: 10234/2
Amdt. dated March 22, 2004
Reply to Office Action of January 21, 2004

REMARKS

Claims 1, 3-5, 8-27, 29, and 31-38 are all the claims pending in the application.

Applicants have amended Claims 4 and 5 to depend from Claim 1, rather than canceled Claim 2.

In addition, Applicants have amended withdrawn method Claim 27 to depend from Claim 1. Where an applicant elects claims directed to a product, and a product claim is subsequently found allowable, withdrawn method claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined (*see*, MPEP §821.04). Accordingly, Applicants respectfully request the rejoinder of claim 27 should the Examiner deem claim 1 to be allowable.

Applicants note with appreciation the Examiner's indication of withdrawn rejections at Section No. 3, page 2, of the Final Action.

At Section 4, page 2, of the Final Action, Claims 1, 3-5, 29, 31-36, and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 4,758,462 to Park, *et al.* ("Park") in view of U.S. Patent 5,006,394 to Baird. The Examiner states that Baird is directed to a film having a high percentage of fillers to increase opacity. The Examiner further states that Baird teaches that stretching the film adds a step to the manufacturing process and increases costs. The Examiner concludes that it would have been obvious to modify Park by reference to Baird motivated by the desire to reduce manufacturing costs.

Applicants respectfully traverse.

The claimed invention is not rendered obvious by Park in view of Baird because the proposed combination of Park and Baird is improper. In particular, the Examiner's proposed combination of the prior art cannot destroy the teachings of the prior art reference being modified. Here, the proposed combination of Park and Baird destroys Park's teachings, and a person of ordinary skill in the art would never have modified Park by reference to Baird.

Park is directed to a biaxially oriented film. Applicants refer to the abstract of Park's disclosure. Each embodiment disclosed in Park is a biaxially oriented embodiment, and Park

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specifically teaches the benefits and advantages of biaxial orientation at column 4, lines 51-63. For example, Park discloses that the biaxial orientation improves physical properties of the film, such as flex-cracking resistance, Elmendorff tear strength, elongation, tensile strength, impact strength, and cold strength properties.

Park teaches that its films must be stretched and, as a result, Park's films necessarily contain voided layers. Modifying Park by not stretching the films disclosed therein would directly contradict and destroy Park's teachings.

Park discloses the following objects for its polymer film structures: (1) to impart them with significantly reduced light transmission characteristics; (2) to provide them with maximum opacity at minimum levels of light-absorbing pigment; (3) to obtain opacities of up to 85% or more; and (4) to present processes for preparing them. Column 3, lines 55-65. Park discloses that the objects of its invention are achieved by providing a biaxially oriented polymer film. Column 3, lines 65-68. Park discloses that its processes for preparing the films include biaxial orientation. Column 4, lines 41-45.

Accordingly, it is unreasonable to propose that a person of ordinary skill in the art would look to Baird in order to modify Park's disclosure.

For the foregoing reason, Applicants respectfully request that the Examiner reconsider and withdraw the remaining §103 rejection.

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Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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